DOCKET NO.: 133088.00201 (P35262US) **PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Charlton and Porter**

Serial No.: **10/524,082** Group Art Unit: **1645**

Filed: **February 9, 2005** Examiner: **Albert Mark Navarro**

Confirmation No.: **8653**

Title: **Methods For The Treatment Of An Infectious Bacterial Disease With An Anti-Lactone Or Lactone Derived Signal Molecules Antibody**

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Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

RESPONSE TO THE RESTRICTION REQUIREMENT

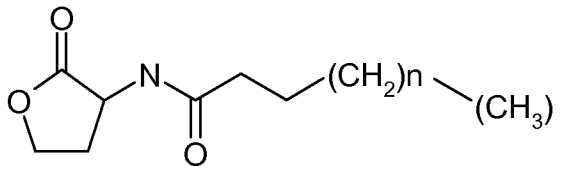
The present Response is filed in regard to the Restriction Requirement mailed June 19, 2007 in connection with the above-identified patent application. The period for responding to the Office Action has been extended, by enclosure of a petition and fee, to and through December 19, 2007.

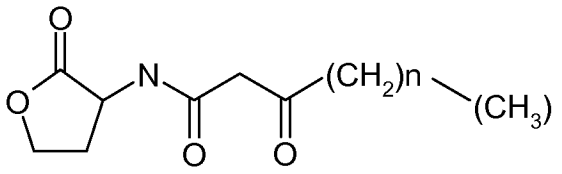
The Examiner has restricted claims 1-13, 17-29, 32, and 33 into ten groups. For example, Group I contains claims 1-13, 17-29, 32, and 33 drawn to monoclonal antibodies to molecules of Formula I. Group II contains claims 1-13, 17-29, 32, and 33 drawn to monoclonal antibodies to molecules of Formula II. Group III contains claims 1-13, 17-29, 32, and 33 drawn to monoclonal antibodies to molecules of Formula III. Applicants elect Group I, containing claims 1-13, 17-29, 32, and 33 drawn to monoclonal antibodies to molecules of Formula I, with traverse.

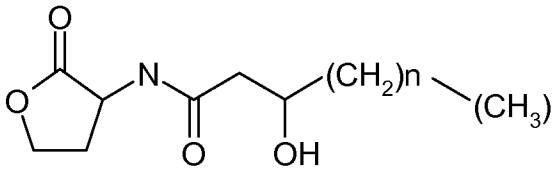
The Examiner states that the Groups do not relate to a single general inventive concept. The Examiner further states that the Groups lack a common special technical feature and that a

monoclonal antibody which binds to a molecule of Formula I will not necessarily bind to any of Groups II-X. Applicants disagree.

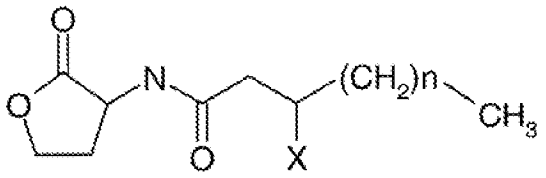
Molecules having Formula I, Formula II, and Formula III (top to bottom) shown below:







share the following common core structure:



where X is H for Formula I, X is (=O) for Formula II, and X is -OH for Formula III. Thus, the molecules of Formula I, Formula II, and Formula III share a common special technical feature.

In addition, Applicants have found that an antibody to a molecule of Formula I also bind to molecules of Formula II and Formula III as well. Indeed, Applicants' specification teaches that a monoclonal antibody that binds to a molecule of Formula I also binds to a molecule of Formula II. For example, Table 2 (see Figure 4/12) shows that antibodies that bind to molecules of Formula I (represented by dDHL and tDHL) also bind to a molecule of Formula II (represented by OHHL). Thus, not only do the molecules of Formula I, Formula II, and Formula

III share a common special technical feature, antibodies that bind to molecules of Formula I also bind to a molecule of Formula II.

Even if the Examiner still considers the groups of claims to be patentably distinct, §803 of the M.P.E.P. mandates two criteria for a proper requirement for restriction: 1) the inventions must be independent or distinct; and 2) there must be a serious burden on the examiner. For purposes of initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in M.P.E.P. §808.02. Significantly, the Examiner has not met the *prima facie* burden. Indeed, the Examiner has not shown separate status in the art or a requirement for a different field of search. Further, the molecules of Formulae I, II, and III would be expected to be classified into identical classes, thus, strongly indicating a lack of serious burden. Furthermore, a search for monoclonal antibodies that bind to a molecule of Formula I would be expected to be duplicative of searches for monoclonal antibodies that bind to molecules of Formulae II and III. Indeed, there is no reason to believe that these searches would not be co-extensive. Accordingly, at the very least, *Groups I, II, and III* should be combined and examined in the present application without restriction.

Applicants submit that the present response is complete and complies with the requirements of 35 U.S.C. §121. In addition, Applicants submit that, at a minimum, claims Groups I, II, and III must be considered in the present application without restriction.

Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (610) 640-7859 if there are any questions regarding Applicants' claimed invention.

The Commissioner is hereby authorized to debit any underpayment of fee due or credit any overpayment to Deposit Account No. 50-0436.

/Paul K. Legaard, Reg.# 38534/
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Date: **18 December 2007**

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